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*JFL*IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Niro Nakamichi et al.

Serial No.: 08/760,706

Filed: December 5, 1996

For: Disk Playback Device

Atty. Docket No.: 004076.73577

Group Art Unit: 2652

Examiner: Cao

Confirmation No.: 8830

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AUG 16 2006

OFFICE OF PETITIONS

Letter

Office Patent Legal Administration  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

The undersigned certifies this paper of 12 pages is  
 being faxed to 571 273 8300 on August 10, 2006

*Christopher R. Glembocki*  
 Christopher R. Glembocki  
 Reg. No. 38,800

Applicants forward a copy of the Petition to Accept Maintenance Fee Unavoidable Delay (11 pages - 4 page petition, 4 page supplemental facts, 2 page statement of Janet Herring, 1 cover sheet, and 1 fax confirmation form) as filed today in the parent of the above-identified application.

Respectfully submitted,  
 BANNER & WITCOFF, LTD.

Dated: August 10, 2006

By:

*Orlare*  
 Christopher R. Glembocki  
 Reg. No. 38,800

101 G Street, N.W.  
 Washington, D.C. 20001-4597  
 Tel: (202) 824-3000  
 Fax: (202) 824-3001

Page 1 of 1

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

Niro Nakamichi et al.

Serial No.: 08/760,706

Filed: December 5, 1996

For: Disk Playback Device

Atty. Docket No.: 004076.73577

Group Art Unit: 2652

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Confirmation No.: 3830

**Response to Order to Show Cause**

Office Patent Legal Administration  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby respond to the Order to Show Cause of July 11, 2006, regarding the expiration of U.S. Patent No. 5,123,001.

Applicants are filing herewith a Petition to Accept Late Payment of the Maintenance Fee as Unavoidably Delayed and accompanying statements. The maintenance fee was not timely paid due to unavoidable circumstances.

Applicants request this Reissue application be kept alive until the status of U.S. Patent No. 5,123,001 has been resolved.

Respectfully submitted,  
BANNER & WITCOFF, LTD.



By:

Christopher R. Glembocki  
Reg. No. 38,800

Dated: August 10, 2006

101 G Street, N.W.  
Washington, D.C. 20001-4597  
Tel: (202) 824-3000  
Fax: (202) 824-3001

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PTO/SG/07 (05-03)

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AUG 10 2006

**Certificate of Transmission under 37 CFR 1.8**

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transmitted to the Patent and Trademark Office

on August 10, 2006.

Date



Signature

Christopher R. Glembocki

Typed or printed name of person signing Certificate

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certificate must identify each submitted paper.

U.S. Serial No. 08/760,706 - Response to Order to Show Cause - 1 page

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

08/10/2006 18:42 FAX 202 824 3001  
VO/LV/LVUD 10.36 FAX LVC 024 JUW1

BANNER & WITCOFF  
BANNER & WITCOFF

002/013  
001

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\*\*\* TX REPORT \*\*\*  
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TRANSMISSION OK

AUG 10 2006

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on August 10, 2006.

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Christopher R. Glembocki

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Note: Each paper must have its own certificate of transmission, or this  
certificate must identify each submitted paper.

U.S. Serial No. 07/572,050 - Now USP 5,123,001 Petition to Accept Late  
Payment of Maintenance Fee - Unavoidable - 4 pages

U.S. Serial No. 07/572,050 - Now USP 5,123,001 Petition with Facts - 4 pages

U.S. Serial No. 07/572,050 - Now USP 5,123,001 Statement of Janet Herring -

2 pages

PTO/SB/97 (05-03)

Approved for use through 04/30/2003. OMB 0651-0031

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U.S. Serial No. 07/572,050 - Now USP 5,123,001 Petition to Accept Late Payment of Maintenance Fee - Unavoidable - 4 pages

U.S. Serial No. 07/572,050 - Now USP 5,123,001 Petition with Facts - 4 pages

U.S. Serial No. 07/572,050 - Now USP 5,123,001 Statement of Janet Herring -

2 pages

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/66 (10-02)

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF  
MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(b))Docket Number (Optional)  
004078.00001

Mail to: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Arlington, VA 22313-1450  
Fax: (703) 308-6916

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AUG 10 2006

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information  
(703) 305-9282.

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AUG 16 2006

Patent No. 5,123,001

Application Number 07/572,050

Issue Date June 16, 1992

Filing Date August 23, 1990

OFFICE OF PETITIONS

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number (or reissue patent number, if a reissue) and (2) the application number of the actual U.S. application (or reissue application) leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

## Also complete the following information, if applicable

## The above-identified patent:

is a reissue of original Patent No. \_\_\_\_\_, original issue date \_\_\_\_\_;  
original application number \_\_\_\_\_;  
original filing date \_\_\_\_\_.

resulted from the entry into the U.S. under 35 U.S.C. 371 of international  
application \_\_\_\_\_ filed on \_\_\_\_\_.

## CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

08/15/2006 DATED

00000123 190733 5123001

Signature

01 FC:1553  
02 FC:15573800.00 DA  
700.00 DA

Typed or printed name of person signing Certificate

[Page 1 of 4]

This collection of information is required by 37 CFR 1.3xx. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take xx minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

PTO/SB/65 (10-02)

Approved for use through 12/31/2002 OMB 0651-0018

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number.

## 1. SMALL ENTITY

Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

## 2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g).

## 3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
<input type="checkbox"/> \$ _____	3 1/2 yr fee	(1551)	<input type="checkbox"/> \$ _____	3 1/2 yr fee	(2551)
<input type="checkbox"/> \$ _____	7 1/2 yr fee	(1552)	<input type="checkbox"/> \$ _____	7 1/2 yr fee	(2552)
<input checked="" type="checkbox"/> \$ 3,800	11 1/2 yr fee	(1553)	<input type="checkbox"/> \$ _____	11 1/2 yr fee	(2553)

MAINTENANCE FEE BEING SUBMITTED \$3,800

## 4. SURCHARGE

The surcharge required by 37 CFR 1.20(l)(1) of \$700 (Fee Code 1558) must be paid as a condition of accepting unavoidably delayed payment of the maintenance fee.

SURCHARGE BEING SUBMITTED \$700

## 5. MANNER OF PAYMENT

Enclosed is a check for the sum of \$\_\_\_\_\_.

Please charge Deposit Account No. 19-0733 the sum of \$4,500. A duplicate copy of this authorization is attached.

Payment by credit card. Form PTO-2038 is attached.

## 6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

The Commissioner is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account No. 19-0733. A duplicate copy of this authorization is attached.

(Page 2 of 4)

PTO/SB/65 (10-02)

Approved for use through 12/31/2002, OMB 0651-0016

Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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## 7. OVERPAYMENT

As to any overpayment made please

OR

Credit to Deposit Account No. 19-0733.

Send refund check.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

## 8. SHOWING

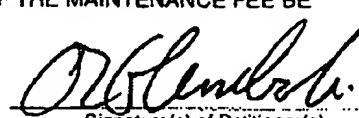
The enclosed statement will show that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The statement must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which the patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

## 9. PETITIONER(S) REQUESTS THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED.

August 10, 2006  
Date

(202) 824 3000

Telephone Number



Signature(s) of Petitioner(s)

Christopher R. Glembocki

Typed or printed name(s)

Banner & Witcoff, LTD., 1001 G St, Suite 1100

Address

Washington DC 20001

## ENCLOSURES:

Maintenance Fee payment

Statement why maintenance fee was not paid timely

Surcharge under 37 CFR 1.20(i)(1) (fee for filing the maintenance fee petition)

\_\_\_\_\_

[Page 3 of 4]

PTO/SB/65 (10-02)

Approved for use through 12/31/2002. OMB 0651-0016  
Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

August 10, 2006

Date



Signature

Christopher R. Glembock

Typed or printed name

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AUG 10 2006**STATEMENT**

(In the space below, please provide the showing of unavoidable delay recited in paragraph 8 above)

See attached sheets.

(Please attach additional sheets if additional space is necessary)

(Page 4 of 4)

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Petition re U.S. Patent No. 5,123,001

AUG 10 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Niro Nakamichi et al.

Serial No.: 07/572,050

Filed: August 23, 1990

For: Disk Playback Device

Atty. Docket No.: 004076.00000

Group Art Unit:

Examiner:

Confirmation No.:

RECEIVED  
AUG 16 2006  
OFFICE OF PETITIONSPetition to Accept Late Payment of Maintenance Fee as  
Unavoidably Delayed

Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

Applicants hereby petition to accept the late payment of the maintenance fee as unavoidably delayed.

1. Banner & Witcoff tracks maintenance fees through our docketing system and Computer Patent Annuities (CPA). Once a matter is entered into our docketing system, the system generates various reminders to ensure that maintenance fees are timely paid.
2. U.S. Patent Application No. 07/572,050 that matured into U.S. Patent No. 5,123,001 (the '001 Patent) was filed by the Morrison Law Firm of New York, New York.
3. A Reissue of the '001 Patent was filed on May 27, 1994 and assigned U.S. Application Serial No. 08/250,667 (now U.S. Serial No. 08/760,706).
4. The attorney originally in charge of the Reissue application left the Morrison Law Firm to join Banner & Witcoff, LTD. in 1997. The Reissue application was later transferred to Banner & Witcoff, LTD. in March of 1998. Upon arrival at Banner & Witcoff, the Reissue application was assigned our reference number 004076.73577. Once assigned a reference number, the docketing department of Banner & Witcoff is able to search for the reference number based on other

## Petition re U.S. Patent No. 5,123,001

information including the U.S. Serial Number or U.S. Patent Number. Prosecution of the Reissue application has continued under this reference number. Applicants last formal submission in the Reissue application was a response of October 8, 2004 to a Quayle Action. The undersigned requested the status of this application on August 8, 2005, by calling the Examiner. The Examiner indicated that a Notice of Allowance had been prepared by not mailed.

5. While the Reissue application was transferred to Banner & Witcoff, the original parent patent, the '001 Patent, was not. No separate reference number was assigned to the '001 Patent as Banner & Witcoff was not responsible for the maintenance fee of the '001 Patent in March 1998.
6. Subsequently, in July 1999, the assignee requested Banner & Witcoff to pay the 7 ½ year maintenance fee for the '001 Patent. While the 7 ½ year maintenance fee was paid and the mailing address for future correspondence for the '001 Patent requested to be changed to Banner & Witcoff's mailing address, no separate matter was opened for the '001 Patent. The responsibility to ensure that all patents that have future maintenance fees due (and future foreign annuity matters) rested on the clerk who handles renewals. The clerk responsible for opening a file corresponding to the '001 patent for the payment of the 11 ½ year maintenance should have but did not open a Banner & Witcoff file to handle all future maintenance fees for the '001 patent. This clerk was subsequently terminated from employment.
7. The undersigned has checked the Banner & Witcoff firm's PTO correspondence log and verified that a patent expiration notice was received in July 2004 for failure to pay the 11 ½ year maintenance fee. Because the '001 Patent was not assigned a separate reference number by the July 2004 date, there would have been no Banner & Witcoff docketable entry to search for based on the expiration notice of the '001 Patent. There is no record of this expiration notice ever have been associated with the Reissue application.
8. In accordance with standing procedures in the firm, the docketing staff would have forwarded the expiration notice to the clerk handling maintenance fees (different from above). The clerk should have attempted to resolve why Banner &

## Petition re U.S. Patent No. 5,123,001

Witcoff received the expiry notice for which there was no corresponding Banner & Witcoff reference number. The steps the clerk should have taken but did not included determining the assignee, determining if other matters are being handled for this assignee, and timely bringing the expiry notice to the billing attorney in charge of matters for the assignee. Had the clerk performed these steps, the 11 1/2 year maintenance fee would have been timely paid. The clerk who was in charge of maintenance fees in 2004 is no longer with the firm.

8. The undersigned has received the Order to Show Cause of July 11, 2006, why to not terminate proceedings in the corresponding Reissue application. This Order was the first indication to the Undersigned and other attorneys at Banner & Witcoff that the Reissue application's parent (the '001 Patent) had expired.
9. Applicants submit the failure to pay the maintenance fee was unavoidable due to the failures of two clerks. As shown in the attached Declaration from Janet Herring, Banner & Witcoff's procedure is to timely resolve unmatched maintenance fee notices against known matters and clients and bring maintenance fee issues to the attorney responsible for the client. This procedure provides that the non-payment of the maintenance fee is resolved in a timely manner.
10. At the time of these events, no specific written procedure existed for handling of these types of occurrences, which, to the best of the knowledge of the undersigned, have ever occurred before. Nonetheless, the general instructions to any clerk are and have always been to obtain instructions from a supervisory clerk. However, in view of this circumstance, our procedures are being revised to require clerks to obtain supervisory clerk's evaluation and advice for unmatched matters as occurred here. These procedures will involve at least tracking down of the responsible attorney and resolving the status of the matter.

If the Petitions Examiner feels further information is required, the Petitions Examiner is requested to contact the undersigned so the additional information may be provided.

## Petition re U.S. Patent No. 5,123,001

Applicant hereby petitions that the maintenance fee for the '001 patent be accepted as the maintenance fee was not paid due to unavoidable circumstances.

If any additional fees are required, the Director is authorized to debit our deposit account no. 19-0733 in the appropriate amount.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: August 10, 2006

By:



Christopher R. Glembotck  
Reg. No. 38,800

1001 G Street, N.W.  
Washington, D.C. 20001-4597  
Tel: (202) 824-3000  
Fax: (202) 824-3001

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Statement of Janet Herring

AUG 10 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Niro Nakamichi et al.

Serial No.: 07/572,050 now USP 5,123,001

Filed: August 23, 1990

For: Disk Playback Device

Atty. Docket No.: 004076.00001

Group Art Unit:

Examiner:

Confirmation No.:

Statement of Janet Herring

Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

I, Janet Herring, state as follows:

1. I have been employed at Banner & Witcoff for over three years.
2. I am in charge of the renewals department at Banner & Witcoff. Our department handles payments of maintenance fees.
3. The firm's docketing department forwards all maintenance fee notices to our department, where they are checked against our records. If a notice cannot be resolved, our procedure is to determine if it belongs to one of the attorneys at Banner & Witcoff, LTD. This procedure includes determining if other matters for the assignee are being handled by the firm and bringing the expiration notice to the billing attorney's attention.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Page 1 of 2